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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,018	04/06/2001	Robert Lawrence Prosise	8038M	6388

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EXAMINER
PRATT, HELEN F

ART UNIT	PAPER NUMBER
1761	6

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/828,018	PROSISE ET AL.
	Examiner	Art Unit
	Helen F. Pratt	1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence addr ss --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-124* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-124* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-124 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No. 09/828,016. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variations in terms of amounts, water activities, and taste values of each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 17, 29 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 is indefinite in the use of the phrase "at least 75% active". It is not known what is intended by this phrase.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6-16, 18-28, 30-40, 42-124 (except further claims to the fiber as in claims 5, 17, 29 and 41 and on) are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard (4,900,566) or Michnowski (4,859,475).

Howard discloses a confectionery product in the form of a bar, which can be a meal replacement. The bar contains 100% of the recommended daily allowance and fiber (col. 10, lines 65-68). At least 5 grams of an amino acid source is disclosed in the use of 5-18 grams of protein in the reference (col. 3, lines 50-51). Fat is disclosed in amounts of from 3 to 25 grams (col. 11, lines 45-55). . Michnowski discloses a high protein nutritionally balanced snack (abstract and col. 2, lines 54-65). Also, disclosed therein is a food bar containing 25% proteins (col. 1, lines 31-40). The water activity is seen to have been within the claimed value because there is no added water (ex. 1-2). Claim 1 differs

form the references in the particular confidence level, in the taste value. However, applicants have disclosed that it is known how to test for these values (Information Disclosure Form). It is not seen that the foods of the above references do not have these values. Attention is invited to In re Levin, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. In re Benjamin D. White, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

The discovery of an optimum value of a result effective variable is ordinarily within the skill of the art. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). In developing a RTE product, properties such as nutrition, preservation and shelf life are important. It appears that the precise ingredients as well as their proportions affect the nutrition, preservation and shelf

life of the product, and thus are result effective variables, which one of ordinary skill in the art would routinely optimize. Therefore, it would have been obvious to make a product containing the claimed ingredients and other parameters and to tailor the product to achieve a particular confidence level.

Claims 2 and 3 further require less water activity and amounts of fat and other ingredients (adjuncts). However, the reference to Howard discloses the use of vitamins and minerals and other ingredients (col. 8, lines 26-70). The further reduction of water activity is seen to have been within the skill of the ordinary worker as this involves the addition of ingredients, which makes water unavailable, or the use of less water in the composition. The particular taste values are seen to have been within the skill of the ordinary worker. In addition, nothing is seen that the cited compositions are not within the claimed values. The bar of Michnowski as in claim 4 is extruded (col. 9, lines 29-47). Therefore, it would have been obvious to make products with varying ingredients and taste values as claimed because as in In re Levin, and in In re Boesch above, nothing new is seen in adding and subtracting ingredients, and in varying the amounts absent anything new or unobvious and nothing has been shown that the taste values are not present in the claimed composition.

Claim 6 requires a particular amino acid score. As the availability of amino acids is well known, it would have been within the skill of the ordinary worker to choose types of protein containing such a particular score since proteins such as milk and eggs which are commonly used in foods are considered to have an amino acid level near 1 being complete proteins. Various

types of proteins are disclosed by Michnowski (col. 5, lines 50-63). Therefore, it would have been obvious to use complete proteins or nearly complete proteins in a nutritional product in order to achieve a particular level of nutrition.

Claims 7-9 require particular types of fats and indigestible fats or digestible fats (lipids) in particular amounts. However, nothing new is seen in the use of the claimed fats which are used for their known function. The use of lesser fats is within the skill of the ordinary worker to vary (Boesch, supra). Therefore, it would have been obvious to use known fats in the composition of the references in particular amounts.

Claim 10 requires particular fibers which are listed in the specification having known manufacturers. As the fibers are known, it would have been obvious to use them in place of the fibers of the references for their known function of providing bulk.

Claim 11 requires particular vitamins and minerals. Howard discloses the use of all trace elements and vitamins required by man (col. 8, lines 6-25). The particular amounts are seen as being within the skill of the ordinary worker depending on the degree of fortification required particularly as the use of the Recommended Daily allowances of vitamins and minerals is a settled matter. Therefore, it would have been obvious to use known elements for their known functions in the claimed composition.

The further limitations are obvious variations of the above claims except as below and have been discussed above.

Claims 5, 17, 29 and 41 and further similar fiber claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard or Michnowski as applied to claims 1-4, 6-16, 18-28, 30-40 above, and further in view of Wong et al. (2002/0037355A1).

Claims 5,17, 29 and 41and further claims concerning fiber further require that the fiber source is 75% active and can be a soluble fiber or insoluble fiber, with each type of fiber having particular characteristics. Wong et al. disclose a spread containing fiber. The fiber can be FIBERSOL (trademark) as disclosed in applicants' specification on page 21, lines 20-25). For soluble fiber a particular viscosity is claimed which is not cited in the reference. However, as it is known that fibers hydrate and can make a solution viscose according to the amount of fiber added to the solution, it would have been within the skill of the ordinary worker to use the appropriate amount of fiber for whatever viscosity was required for the product. It is noted that as in claim 4, various types of products are claimed, which would require various viscosities. Therefore, it would have been obvious to use a particular amount of fiber to make a particular viscosity in the claimed composition.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-1978. The examiner can normally be reached on Monday, Wednesday and Friday from 9:30 to 6:00 and Tues and Thurs. from 4:30 to 10 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on (703) 3959. The fax

phone number for the organization where this application or proceeding is assigned is 703-308-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

Hp 1-21-03

H. Pratt

HELEN PRATT
PRIMARY EXAMINER